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MAR 28 2007

Docket No. BB-130  
Serial No. 10/525,685

11

Remarks

Claims 24-40 were pending in the subject application. By this Amendment, the applicants have amended claims 24, 26, 29, 30, 36 and 38 and have cancelled claims 27, 28, 39 and 40. No new subject matter has been added by these amendments. Accordingly, claims 24-26 and 29-38 are supported by the specification and are now before the Examiner for consideration.

Initially, the applicants would like to thank the examiner for the indication of allowable subject matter.

The amendments set forth herein should not be interpreted to indicate that the applicants have agreed with, or acquiesced to, the rejections set forth in the outstanding Office Action. The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. Favorable consideration of the claims now presented, in view of the remarks and amendment set forth herein, is earnestly solicited.

Claims 36-40 have been rejected under 35 U.S.C. §112, first paragraph. The applicants respectfully traverse this ground for rejection to the extent that it might be applied to the claims now pending. In this regard, please note that claims 39 and 40 have been cancelled herein and that claim 36 has been amended to recite only the treatment of retroviral diseases.

Retroviruses are, of course, a well known category of viruses that are typified by, for example, HIV (as disclosed at page 8 and throughout the applicants' disclosure). The applicants respectfully submit that the person skilled in this field could readily and without undue experimentation utilize the compounds of the current invention for the treatment of the narrow category of diseases caused by retroviruses.

It is important to bear in mind that for an invention to be enabled under the first paragraph of 35 U.S.C. §112, the specification need only teach a person of ordinary skill in the art "how to make" and "how to use" the invention. Furthermore, it should be noted that the requirement for some experimentation does not necessarily make a claim non-enabled. "Enablement is not precluded by the necessity for some experimentation such as routine screening. . . A considerable amount of experimentation is permissible, if it is merely routine . . ." *In re Wands*, 8 USPQ 2d 1400, 1404 (Fed. Cir. 1988).

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With regard to the *Wands* factors, the claims are now narrowly drawn to the use of the claimed compounds for a specific type of disease. Certainly, the highly skilled artisan in this field would have no trouble making and administering the claimed compounds with a reasonable expectation of success in treating the specific conditions now claimed.

Thus, in view of the amendments to the claims, the applicants respectfully submit that one skilled in the art could readily, and without undue experimentation, make and use the compounds as currently claimed. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

Claim 29 has been rejected under 35 U.S.C. §112, second paragraph. By this amendment claim 29 has been amended to lend greater clarity to the claimed subject matter. Specifically, references to "derivatives" and "analogs" have been removed from the claim. In view of these amendments the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

Claim 29 has been rejected under 35 U.S.C. §112, first paragraph. As noted above, by this Amendment, claim 29 has been amended to delete reference to derivatives and analogs. Therefore, the applicants respectfully submit that the "written description" rejection under 35 U.S.C. §112, first paragraph, of claim 29 has been rendered moot.

Claims 26-28 have been rejected under 35 U.S.C. §112, second paragraph. By this Amendment, the applicants have amended claim 26 to specify that the claimed method is carried out by growing the fungus in a marine organism (and claims 27 and 28 have been cancelled). Fortunately, the method of this aspect of the invention is rather straightforward and does not involve steps other than those which are now recited in claim 26. Thus, the applicants respectfully submit that the claims, as amended, fully set forth the metes and bounds of the claimed subject matter. Accordingly, the applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

Claims 24-40 have been objected to because of informalities. By this Amendment, claims 24, 26, 29, 30 and 36 have been amended to correct the spelling of "consisting" in these claims. Claim 29 has been amended to change "amino acid" from singular form to plural form.

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13

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Serial No. 10/525,685

In response to the defective Oath or Declaration, attached herewith is a new Declaration and Power of Attorney form executed by Gerhard Lang thereby rendering moot this rejection of the defective Oath or Declaration.

In view of the foregoing remarks and the amendments above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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